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IN THE UNITED STATES PATENT OFFICE

In re: Klimko et al.

Serial No. NYA

Filed: August 21, 1997

For: USE OF CLOPROSTENOL AND
FLUPROSTENOL ANALOGUES TO
TREAT GLAUCOMA AND OCULAR
HYPERTENSION

Assistant Commissioner for Patents
Box: Patent Applications
Washington, D.C. 20231

Sir:

This is a request for filing a (Continuation / Divisional) application under Rule 60 of pending:

Serial No. 08/769,293, filed December 18, 1996

1. Enclosed is a copy of the prior application as originally filed (including the specification (with claims) drawings, and oath or declaration); and I hereby verify that such copy is a true copy of the prior complete application.
2. Enclosed is a Preliminary Amendment.
3. Enclosed is a copy of the Petition for Correction of Inventorship (with supporting statements and consents) filed pursuant to 37 CFR § 1.48 in the prior application to include Paul W. Zinke as a co-inventor.

4. Enclosed is Form PTO-1449, along with Information Disclosure Statement, listing and enclosing copies of thirty-three (33) references.

5. The filing fee is calculated below:

CLAIMS AS AMENDED BY PRELIMINARY AMENDMENT

| FOR | NO. FILED | NO. EXTRA | RATE | TOTALS |
|--|--------------|------------------|----------|----------|
| TOTAL CLAIMS | 22 ____ - 20 | 2 | \$ 22.00 | 44.00 |
| INDEPENDENT CLAIMS | 2 ____ 3 | 0 | \$ 80.00 | 0.00 |
| XXXXXXXXXXXXXXXXXXXXXXXXXXXXXX XXXXXXXXXXXXXXXXXXXXXXXXXXXXXX XXXXXXXXXXXXXX | | <i>BASIC FEE</i> | | \$770.00 |
| | | <i>TOTAL FEE</i> | | \$814.00 |

6. Please charge the \$814.00 filing fee to Deposit Account No. 01-0682. A duplicate copy of this sheet is enclosed
7. The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 01-0682. A duplicate copy of this sheet is enclosed.
8. Cancel in this application original claims [see Preliminary Amendment of the prior application before calculating filing fee].
9. Amend the specification by inserting before the first line the sentence:
10. Transfer the drawings from the prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate copy of this sheet is enclosed for filing in the prior application file.
11. The prior application is assigned to Alcon Laboratories, Inc.

12. The power of attorney in the prior application is to James A. Arno, Reg. No. 26,145; Gregg C. Brown, Reg. No. 30,613; Sally Yeager, Reg. No. 32,757; Julie J. L. Cheng, Reg. No. 33,848; Barry L. Copeland, Reg. No. 34,801; Jeffrey S. Schira, Reg. No. 34,922 and Patrick M. Ryan, Reg. No. 36,263 of Alcon Laboratories, Inc., 6201 South Freeway, Fort Worth, Texas 76134; and Robert L. Price of Lowe, Price, LeBlanc & Becker, Suite 300, 99 Canal Center Plaza, Alexandria, Virginia 22314.
- a. The power appears in the original papers of the prior application.
- b. Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
- c. Please address all future communications to:

Barry L. Copeland
Patent Department (Q-148)
Alcon Laboratories, Inc.
6201 South Freeway
Fort Worth, Texas 76134
(817) 551-4322

Respectfully submitted,

ALCON LABORATORIES, INC.

8-21-97
Date


Barry L. Copeland
Registration No. 34,801

Barry L. Copeland
Patent Department (Q-148)
Alcon Laboratories, Inc.
6201 South Freeway
Fort Worth, TX 76134
(817) 551-4322

Docket No. 1407B

IN THE UNITED STATES PATENT OFFICE

In re: Klimko et al.

Serial No: 08/769,293

Filed: December 18, 1996

Examiner: NYA

Group Art Unit: 1209

For: USE OF CLOPROSTENOL
AND FLUPROSTENOL
ANALOGUES TO TREAT
GLAUCOMA AND OCULAR
HYPERTENSION

CERTIFICATE OF MAILING
BY EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EM455926259US in an envelope addressed to: Assistant Commissioner for Patents, Box Issue Fee, Washington, D.C. 20231 on this date:

Date: 4-24-97
Name: Dawn Fedyniak
Dawn Fedyniak

**PETITION FOR CORRECTION OF INVENTORSHIP
UNDER 37 CFR §1.48(a)**

Assistant Commissioner for Patents
BOX ISSUE FEE
Washington, DC 20231

Sir:

Applicants hereby petition to amend the above referenced application to name all of the actual inventors, one of whom was inadvertently omitted upon the filing of the parent application to the present application. In accordance with 35 CFR § 1.48(a), this Petition is accompanied by:

1. A Statement Of Facts verified by the original named inventors establishing when the error, without deceptive intention, was discovered and how it occurred;
2. A Declaration by each of the actual inventors, as required by 37 CFR § 1.63; and

COPY

3. The written consent of Alcon Laboratories, Inc., the assignee of record.

The Commissioner is authorized to deduct the \$130 processing fee for the Petition pursuant to 37 CFR § 1.17(h). The Commissioner is also hereby authorized to charge any additional fees which may be required or to credit any overpayment to Deposit Account No. 01-0682. A duplicate copy of this letter is attached.

Respectfully submitted,

ALCON LABORATORIES, INC.

Date: 4-24-97

By: 
Barry L. Copeland
Reg. No. 34,801

Patent Department (Q-148)
Alcon Laboratories, Inc.
6201 South Freeway
Fort Worth, Texas 76134
(817) 551-4322

Atty. Docket No. 1407A

IN THE UNITED STATES PATENT OFFICE

In re: Klimko et al.

Serial No: 08/769,293

Filed: December 18, 1996

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Date: 4-24-97
Name: Dawn Fedyniak
Dawn Fedyniak

**STATEMENT OF FACTS IN SUPPORT OF PETITION FOR CORRECTION
OF INVENTORSHIP UNDER 37 CFR §1.48(a)**

Assistant Commissioner for Patents
BOX ISSUE FEE
Washington, DC 20231

Sir:

We, **Peter G. Klimko, John E. Bishop, and Verney L. Sallee**, hereby declare and say as follows:

1. We are the originally named inventors of the above-identified application, which is assigned to Alcon Laboratories, Inc.
2. The above-identified application discloses and claims methods and compositions for treating glaucoma and ocular hypertension utilizing analogs of cloprostenol and fluprostenol. The present application is a continuation of U.S. Application Serial No. 08/280,681 filed July 26, 1994 (the "Parent Application"). We

understand that shortly after filing the Parent Application, the Alcon Laboratories patent attorney responsible for the matter left the employ of Alcon, and another Alcon patent attorney, Barry Copeland, assumed responsibility for the prosecution of the application.

3. We further understand that when it became apparent that certain claims of the Parent Application might be considered allowable, Dr. Mark Hellberg advised Mr. Copeland of his belief that Dr. Paul W. Zinke, an Alcon scientist, should be considered as a possible joint inventor. Dr. Hellberg is Alcon's prostaglandin research team leader and is familiar with the contributions made by the research scientists to Alcon's prostaglandin related inventions.

4. Subsequent to receiving Dr. Hellberg's suggestion, we understand that Mr. Copeland reviewed the Parent Application file, but was unable to locate any notes of the former patent attorney or any other written information that would provide a basis for the original inventorship determination. We understand that Mr. Copeland then interviewed several of the scientists involved in the research work that led to the present invention, including at least one of the originally named inventors. Based upon his investigation, we understand that Mr. Copeland concluded that Dr. Zinke contributed materially to the present invention and should therefore be named as a joint inventor. We agree.

5. We believe that the former patent attorney, who was making a very diligent effort to finalize a number of patent applications before departing from Alcon, simply neglected to include Dr. Zinke as an inventor in the Parent Application, and that Dr. Zinke should therefore be included as a joint inventor in the present application.

6. Thus, while we in good faith represented ourselves to be the only inventors at the time the Parent Application was originally filed, we did not at that

time fully appreciate the contributions of Dr. Zinke to the invention as claimed, and therefore may have failed to effectively communicate the extent of those contributions to the former patent attorney. It is under these circumstances that Dr. Zinke's name was omitted as a joint inventor on the Parent Application.

7. We affirm our belief that the omission of Dr. Zinke as a joint inventor on the Parent Application was totally inadvertent and without any deceptive intent.

8. Upon information and belief, Mr. Copeland diligently advised the patent examiner handling the Parent Application of his intention to file a Petition for Correction of Inventorship. However, because the Parent Application was then under a final rejection, it was decided that the Petition for Correction of Inventorship should be filed with the present continuation application.

9. For all of the foregoing reasons, we respectfully request that this Petition to include Dr. Paul Zinke as a joint inventor on the present application be granted.

10. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both,

under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

4-14-97

Date

Peter G. Klimko

Peter G. Klimko

09 APR 97

Date

John E. Bishop

John E. Bishop

April 14, 1997

Date

Verney L. Sallee

Verney L. Sallee

Atty. Docket No. 1407A

COMBINED DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if more than one name is listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

"USE OF CLOPROSTENOL AND FLUPROSTENOL ANALOGUES TO TREAT GLAUCOMA AND OCULAR HYPERTENSION "

the specification of which:

- is attached hereto.
- was filed by an authorized person on my behalf on July 26, 1994, and assigned U.S. Patent Application Serial No. 08/280,681 (the "Parent Application").

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations ("37 CFR"), Section 1.56 which states: in part:

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned.

Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) *it establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or*
- (2) *it refutes, or is inconsistent with, a position the applicant takes in:*
 - (i) *opposing an argument of unpatentability relied on by the office;*
or
 - (ii) *asserting an argument of patentability*

I hereby claim the benefit under Title 35, United States Code ("35 USC"), Section 120, of any United States Application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Section 112, I acknowledge the duty to disclose material information as defined in 37 CFR, Section 1.56(a), which occurred between the filing date of the prior application and the national or PCT international filing date of the Parent Application of which the

present application is a file wrapper continuation:

| Application Serial No. | Filing Date | Status |
|------------------------|----------------|--|
| 08/101,598 | August 3, 1993 | Issued as U.S. Patent No. 5,510,383 |

As to the subject matter of this application which is common to said earlier application, I do not know and do not believe that the same was ever known or used in the United States of America before my invention thereof or patented or described in any printed publication in any country before my invention thereof, or more than one year prior to said earlier application, or in public use or on sale in the United States of America more than one year prior to said earlier application; that said common subject matter has not been patented or made the subject of an inventor certificate issued before the date of said earlier application in any country foreign to the United States of America or on an application filed by me or my legal representatives or assigns more than twelve months prior to said earlier application; and the earliest application(s) for patent or inventor's certificate on said invention filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified below, as well as all other applications (if any) filed more than twelve months prior to the filing date of the Parent Application:

NONE.

The priority of the earliest application(s) (if any) filed within a year prior to said pending prior application is hereby claimed under 35 USC Section 119.

As to the subject matter of this application which is not common to said earlier application, as of the date of filing the Parent Application, I did not know and did not believe that the same was ever known or used in the United States of America before my or our invention thereof or patented or described in any printed

publication in any country before my or our invention thereof or more than one year prior to the date of said Parent Application, or in public use or on sale in the United States of America more than one year prior to the date of said application, and that said subject matter has not been patented or made the subject of an inventor's certificate issued in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to the date of said application, and that the earliest application(s) for patent or inventor's certificate on said subject matter filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified below, as well as all other such applications) (if any) filed more than twelve months prior to the filing date of said Parent Application.

NONE.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint James A. Arno, Reg. No. 26,145; Gregg C. Brown, Reg. No. 30,613; Sally Yeager, Reg. No. 32,757; Barry L. Copeland, Reg. No. 34,801; Jeffrey S. Schira, Reg. 34,922; and Patrick M. Ryan, Reg. No. 36,263, Michael C. Mayo, Reg. No. 38,545 of ALCON LABORATORIES, INC., 6201 South Freeway, Fort Worth, Texas 76134, and Robert L. Price, Reg. No. 22,685, of Lowe, Price, LeBlanc & Becker, 99 Canal Center Plaza, Suite 300, Alexandria, Virginia 22314, my attorneys, with full power of substitution and revocation, to prosecute this application

and to transact all business in the United States Patent and Trademark Office connected therewith.

Please direct all correspondence concerning this application to: Barry L. Copeland, Patent Department Q-148, ALCON LABORATORIES, INC., 6201 South Freeway, Fort Worth, Texas 76134, Telephone No. (817) 551-4322.

Full name of joint inventor:

Peter G. Klimko

Residence/Post Office Address:

2115 Pembroke Drive
Fort Worth, Texas 76110

Inventor's Signature:

Peter G. Klimko

4-13-97

Date:

United States

Citizenship:

Full name of joint inventor:

John E. Bishop

Residence/Post Office Address:

878 Townsend Road
Groton, Massachusetts 01450

Inventor's Signature:

John E. Bishop

08 Apr 97

Date:

United States

Citizenship:

Full name of joint inventor:

Verney L. Sallee

Residence/Post Office Address:

304 Diamond Lane
Burleson, Texas 76028

Inventor's Signature:

Verney L. Sallee
April 19, 1997

Date:

United States

Full name of joint inventor:

Paul W. Zinke

Residence/Post Office Address:

4129 Willow Way Road
Fort Worth, Texas 76133

Inventor's Signature:

Paul W. Zinke
April 21, 1997

Date:

United States

Citizenship:

2000-00000000000000000000000000000000

Attorney Docket No. 1407A

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Date: 4-24-97
Name: Dawn Fedyniak
Dawn Fedyniak

CONSENT OF ASSIGNEE IN SUPPORT OF PETITION
FOR CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48(a)

Assistant Commissioner for Patents
BOX ISSUE FEE
Washington, DC 20231

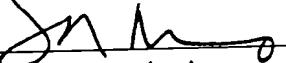
Sir:

Alcon Laboratories, Inc., the assignee of record in the above-identified application, hereby consents to the addition of **Paul W. Zinke** as a co-inventor in the above-identified application. The Assignment in U.S. Patent Application Serial No. 08/280,681, filed July 26, 1994, and parent to the present application, was recorded on September 21, 1994 at Reel 7143, Frame 817-820.

Respectfully submitted,

ALCON LABORATORIES, INC.

Date: April 24, 1997

By: 

James A. Arno
Vice President
Reg. No. 26,145
Alcon Laboratories, Inc.
6201 South Freeway, Q-148
Fort Worth, TX 76134